



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,574	06/22/2001	Henry C. Yuen	36179/WWM/11	9100

7590 03/22/2007
Alexander Shvarts
Fish & Neave
1251 Avenue of the Americas
New York, NY 10020-1105

EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
----------	--------------

2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/807,574

Applicant(s)

YUEN, HENRY C.

Examiner

Dominic D. Saltarelli

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-16 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 21, 2006 has been entered.

Response to Arguments

2. Applicant's arguments filed January 22, 2007 have been fully considered but they are not persuasive.

First, applicant argues that there is no motivation to combine the Knudson reference with the Zigmond reference (applicant's remarks, pages 5-6).

In response, the cited portion of Zigmond provides the necessary objective teaching to motivate one of ordinary skill in the art to modify Knudson in view of Zigmond. The modification made involved selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile. The motivation provided was the benefit of conserving memory in the receiver. The cited portion of Zigmond, col. 15, lines 17-34 explicitly state "Such a prefiltering process is useful when an advertisement repository 86 is capable of storing a limited number of advertisements."

Second, applicant argues that the examiner relied upon improper hindsight when reconstructing applicant's claimed invention (applicant's remarks, page 6-7).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As demonstrated above, each claimed element and the motivation to combine are all found within the prior art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5, 7, 11-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US 2003/0110499 A1, of record) [Knudson] in view of Zigmond et al. (6,698,020, of record) [Zigmond].

Regarding claims 1 and 15, Knudson discloses a method and system for targeting advertisements to television viewers (paragraph 0008) that have a television receiver (fig. 1, set top 48) and a television screen (fig. 1, television 52), the method comprising the steps of:

displaying an EPG on the television screen (figs. 4-15 and 17-21), wherein EPG data is stored in an EPG data base (fig. 1, program guide database 34);

monitoring use of the EPG (fig. 3, "determine user preferences by monitoring user interactions with program guide" 60);

developing a viewer profile based on viewer usage of the EPG using data from the EPG data base (paragraphs 0057-0058 and 0071-0072);

receiving a plurality of advertisements with a television signal at the receiver (paragraph 0054); and

displaying one of the stored advertisements on the screen in the EPG (figs. 4-15 and 17-21, and paragraph 0087).

Knudson fails to disclose selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile.

In an analogous art, Zigmond teaches selectively storing fewer than all of received advertisements at a receiver depending on a viewer profile in order to conserve memory in the receiver (col. 15, lines 17-34).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Knudson to include selectively storing fewer than all of received advertisements at a receiver depending on a

viewer profile, as taught by Zigmond, for the benefit of conserving memory in the receiver.

Regarding claim 3, Knudson and Zigmond disclose the method of claim 1, wherein the received advertisements are embedded in a television signal (Knudson, paragraphs 0044-0046).

Regarding claim 4, Knudson and Zigmond disclose the method of claim 3, wherein the receiver receives an analog broadcast, and the received advertisements are embedded in the VBI (Zigmond, col. 16, lines 44-56).

Regarding claim 5, Knudson and Zigmond disclose the method of claim 3, wherein the television signal is formatted as a digital video stream, wherein the received advertisements are embedded in the video stream (digital satellite broadcast, Zigmond, col. 17 line 50 – col. 18 line 6).

Regarding claims 7, 11, 12, and 13, Knudson and Zigmond disclose the method of claim 1, wherein the EPG database includes the time, channel, and program category identifiers of telecast television programs (Knudson, paragraph 0089), the EPG displaying step permits viewers to highlight displayed program listings to initiate another action (as shown in fig. 15 of Knudson, highlighted region 192 used for program selection), and the monitoring step retrieves the

program categories of telecast television programs selected by the viewer for display on the screen from the EPG database by addressing the time and channel of such selected television programs (Knudson, broadcast time tag 286 and channel tag 284, shown in fig. 27, see paragraph 0089).

Regarding claim 16, Knudson and Zigmond disclose the system of claim 15, wherein the system is comprised in the television receiver (Zigmond, col. 7, lines 37-67).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson and Zigmond as applied to claim 1 above, and further in view of Dedrick (5,724,521, of record).

Regarding claim 6, Knudson and Zigmond disclose the method of claim 1, but fail to disclose maintaining the viewer profile in a secure file at the receiver.

In an analogous art, Dedrick teaches storing person profile information in a secure file (profile is encrypted to protect it from being accessed by any other user, col. 7, lines 37-49), preventing access to sensitive information that may be in the user's profile (col. 7, lines 16-25 lines 37-49).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Knudson and Zigmond to include maintaining the viewer profile in a secure file at the receiver, as taught by

Art Unit: 2623

Dedrick, for the benefit of protecting the viewer related information stored in the profile.

6. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson and Zigmond as applied to claim 1 above, and further in view of Lawler (5,758,259, of record).

Regarding claim 8, Knudson and Zigmond disclose the method of claim 7, but fail to disclose the monitoring step additionally records the time that programs in each category are displayed such that the storing step stores an advertisement that matches the category having the longest recorded time.

In an analogous art, Lawler discloses a method for tracking viewer preferences to assist in the selection of content (col. 8, lines 51-62) that records the time that programs in different categories are displayed (col. 7 line 44 - col. 8 line 34, where each count represents a recorded minimum of time spent viewing the program, col. 7, lines 47-50, thus the highest count represents the longest recorded time).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Knudson and Zigmond to include recording the time that programs in each category are displayed to assist in the creation of a user profile used for the selection of content, as taught by Lawler, such that the storing step stores an advertisement that matches the category having the

Art Unit: 2623

longest recorded time (those advertisements categorized under categories with the highest count are considered to be of most interest).

Regarding claim 14, Knudson and Zigmond disclose the method of claim 13, but fail to teaches the monitoring step counts by category the number of times the other action is initiated.

In an analogous art, Lawler discloses a method for tracking viewer preferences to assist in the selection of content (col. 8, lines 51-62) that counts by category the viewing of different programming (col. 7 line 44 - col. 8 line 34).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Knudson and Zigmond to include counts by category the number of times the other action is initiated, as taught by Lawler, for the benefit of providing an additional factor to assist in creating a more accurate profile of a viewer used in the selection of advertisements.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson and Zigmond as applied to claim 7 above, and further in view of Young et al. (5,353,121, of record) [Young].

Regarding claim 9, Knudson and Zigmond disclose the method of claim 7, but fail to disclose the EPG displaying step uses the same program category identifiers to compile category program guides.

In an analogous art, Young teaches compiling category program guides for display in an EPG (figs. 14-17), for the benefit of providing theme based guides to assist users in locating desired programming.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Knudson and Zigmond to include compiling category program guides, as taught by Young, wherein the displaying step uses the same program category identifiers to perform said compiling (movies, sport, specials, and TV fare are used consistently, shown in figs. 14 through 17 of Young).

Regarding claim 10, Knudson and Zigmond disclose the method of claim 7, but fail to disclose the EPG displaying step uses different program category identifiers to compile category program guides.

In an analogous art, Young teaches compiling category program guides for display in an EPG (figs. 14-17), for the benefit of providing theme based guides to assist users in locating desired programming.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Knudson and Zigmond to include compiling category program guides, as taught by Young, wherein the displaying step uses different program category identifiers to perform said compiling (the different category identifiers include movies, sport, specials, and TV fare, shown in figs. 14 through 17 of Young).

8. Claims 20, 21, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson in view of Zigmond and Dedrick.

Regarding claims 20 and 24, Knudson discloses a method and system of collecting viewer profile data for a television receiver comprising:

displaying an EPG on the television screen (figs. 4-15 and 17-21), wherein EPG data is stored in an EPG data base (fig. 1, program guide database 34);

monitoring use of the EPG (fig. 3, "determine user preferences by monitoring user interactions with program guide" 60);

developing a viewer profile based on viewer usage of the EPG using data from the EPG data base (paragraphs 0057-0058 and 0071-0072);

receiving a plurality of advertisements with a television signal at the receiver (paragraph 0054); and

displaying one of the stored advertisements on the screen in the EPG (figs. 4-15 and 17-21, and paragraph 0087).

Knudson fails to disclose storing the viewer profile in a secure file and selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile.

In an analogous art, Zigmond teaches selectively storing fewer than all of received advertisements at a receiver depending on a viewer profile in order to conserve memory in the receiver (col. 15, lines 17-34).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Knudson to include selectively storing fewer than all of received advertisements at a receiver depending on a viewer profile, as taught by Zigmond, for the benefit of conserving memory in the receiver.

Knudson and Zigmond fail to disclose storing the viewer profile in a secure file.

In an analogous art, Dedrick teaches storing person profile information in a secure file (profile is encrypted to protect it from being accessed by any other user, col. 7, lines 37-49), preventing access to sensitive information that may be in the user's profile (col. 7, lines 16-25 lines 37-49).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Knudson and Zigmond to include maintaining the viewer profile in a secure file, as taught by Dedrick, for the benefit of protecting the viewer related information stored in the profile.

Regarding claims 21 and 25, Knudson, Zigmond, and Dedrick disclose the method and system of claims 20 and 24, but fail to disclose storing the results further comprises storing the results in a secure file in which the data cannot be accessed from outside the television receiver.

It is notoriously well known in the art to restrict access to profile data stored in a receiver to any device other than the receiver, protecting the user's

Art Unit: 2623

personal information stored in said profile from being accessed and stolen by an outside entity, such as storing the profile in separate section of memory or as a hidden file that is inaccessible from any computer connected to the receiver over a network.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Knudson, Zigmond, and Dedrick to include storing the results in a secure file in which the data cannot be access from outside the television receiver, protecting the user's personal information stored in said profile from being accessed and stolen by a malicious outside entity.

9. Claims 22, 23, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson, Zigmond, and Dedrick as applied to claims 20 and 24 above, and further in view of O'Flaherty et al. (6,253,203, of record) [O'Flaherty].

Regarding claims 22 and 26, Knudson, Zigmond, and Dedrick disclose the method and system of claims 20 and 24, but fail to disclose storing the results further comprises storing the results in a secure file from which only anonymous data can be accessed from outside the television receiver.

In an analogous art, O'Flaherty teaches restricting access by third parties to a locally stored database to only being able to access anonymous data for the benefit of enhancing privacy of personalized information yet maintaining

Art Unit: 2623

controlled access to the data for the benefit of the third parties (col. 4, lines 30-53).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Knudson, Zigmond, and Dedrick to include a secure file from which only anonymous data can be accessed from the outside, as taught by O'Flaherty, for the benefit of enhancing privacy of personalized information yet maintaining controlled access to the data for the benefit of interested third parties.

Regarding claims 23 and 27, Knudson, Zigmond, Dedrick, and O'Flaherty disclose the method and system of claims 22 and 26, wherein the anonymous data is accessed from outside the television receiver by telephone (Zigmond reports data from a receiver to a statistics collection location using phone lines, col. 10, lines 4-15).

10. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson and Zigmond as applied to claims 1 and 15 above, and further in view of Marsh et al. (5,848,397, of record) [Marsh].

Regarding claims 28 and 29, Knudson and Zigmond disclose the system and method of claims 1 and 15, but fail to disclose the advertisement is selected from the sub-plurality of advertisements according to a rotation.

In an analogous art, Marsh teaches displaying selected advertisements according to a rotation (col. 9, lines 7-27), for the benefit of maintaining a fair distribution of the display of advertisements (col. 9, lines 50-64).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Knudson and Zigmond to include selecting the advertisements according to a rotation, as taught by Marsh, for the benefit of maintaining a fair distribution of the display of advertisements.

11. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson, Zigmond, and Dedrick as applied to claims 20 and 24 above, and further in view of Marsh.

Regarding claims 30 and 31, Knudson, Zigmond, and Dedrick disclose the system and method of claims 20 and 24, but fail to disclose the advertisement is selected from the sub-plurality of advertisements according to a rotation.

In an analogous art, Marsh teaches displaying selected advertisements according to a rotation (col. 9, lines 7-27), for the benefit of maintaining a fair distribution of the display of advertisements (col. 9, lines 50-64).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Knudson, Zigmond, and Dedrick to include selecting the advertisements according to a rotation, as taught by Marsh, for the benefit of maintaining a fair distribution of the display of advertisements.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Art Unit: 2623

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Art Unit: 2623


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
Art Uni 2611

DS



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600